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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79009205
Applicant	KTS Co., LTD
Applied for Mark	POWER MAGNUM
Correspondence Address	THOMAS J. MOORE BACON & THOMAS, PLLC 625 SLATERS LANE, FOURTH FLOOR ALEXANDRIA, VA 22314-1176 UNITED STATES MAIL@BACONTHOMAS.COM
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Filer's Name	Thomas J. Moore
Filer's e-mail	tjmoore@baconthomas.com, pmiles@baconthomas.com
Signature	/ThomasJMoore/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Owner/Applicant:	KTS, Co., LTD.
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APPLICANT'S BRIEF

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Thomas J. Moore
Applicant's Attorney

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: 703-683-0500
Fax: 703-683-1080
E-mail: mail@baconthomas.com

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DESCRIPTION OF THE RECORD

The present application was filed on June 3, 2004, as an extension to the United States of International Registration No. 844212.

On April 14, 2005, an Office Action was mailed which cited U.S. Registration No. 1,175,844, objected to the goods as allegedly indefinite, and asserted that a disclaimer of “power” was required.

On October 7, 2005, an Amendment, and a Power of Attorney and Designation of Domestic Representative were filed. The goods were amended, a disclaimer of “power” was added, and the citation of the registration was argued to be erroneous. The submission included copies of a dictionary definition, print outs from the TESS database, and print outs of web pages from the internet.

On November 18, 2005, an Office Action was mailed which included a new objection to the identification of goods, and maintained the citation of the registration.

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On April 24, 2006, an Amendment was filed which amends the goods and argues against the cited registration.

On June 9, 2006, a final Office Action was mailed which accepts the amended identification of goods and maintains the citation of the registration.

On October 18, 2006, an Amendment and Request for Reconsideration was filed which amends the goods and argues against the cited registration.

On December 4, 2006, an Office Action was mailed which maintains the citation of the registration, and accepts the amended identification of goods.

On December 5, 2006, a Notice of Appeal was filed together with a Declaration. The Notice of Appeal requested suspension of the appeal and remand of the application to the examining attorney for consideration of the Declaration.

On December 22, 2006, the Trademark Trial and Appeal Board mailed an Office Action which suspends of the appeal and remands of the application to the Examining Attorney.

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On February 16, 2007, an Office Action was mailed which maintains the citation of the registration, after consideration of the Declaration.

On February 28, 2007, the Trademark Trial and Appeal Board mailed an Office Action which allows 60 days in which to file Applicant's brief.

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STATEMENT OF THE ISSUE

Whether the Office Action dated February 16, 2007, which maintains the final refusal in the Office Action dated June 9, 2006, is correct in asserting that Applicant's mark is likely to be confused with the mark of the cited registration, and precluded from registration by Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d) (1999).

The cited registration is U.S. Registration No. 1,175,844 (the "registered mark") of the trademark MAGNUM for "electrically powered tools-namely, drills and screwdrivers."

The present application requests registration of the mark shown below for "air-operated hand-held tools, namely, air-operated impact wrenches, and air-operated ratchet wrenches":

***Power
Magnum***

ARGUMENT

I. THE STANDARD OF REVIEW.

In ex parte cases, the question is simply "whether or not, based on the record before the examiner, the examiner's action was correct." *In re Bose Corp.*, 772 F.2d 866, 869 (Fed. Cir. 1985). See also *In re AFG Industries, Inc.*, 17 U.S.P.Q.2d 1162 (T.T.A.B. 1990) (In determining an ex parte appeal, the Appeal Board's sole task is "to determine if the refusal to register was correctly made." *Id.* at 1163).

II. ALL RELEVANT FACTORS SHOULD BE CONSIDERED WHEN EVALUATING AN ALLEGATION OF A LIKELIHOOD OF CONFUSION.

It is well established that "in determining the issue of likelihood of confusion, [one] must consider those of the thirteen evidentiary factors listed in the case *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), which are of record and pertinent to the case in question." *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, 21 USPQ2d 1142 (Fed. Cir. 1991). The thirteen Du Pont factors are as follows:

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- (1) similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression
- (2) similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which buyers to whom sales are made, i.e. "impulse" versus careful, sophisticated purchasing;
- (5) fame of the prior mark;
- (6) number and nature of similar marks in use on similar goods;
- (7) nature and extent of any actual confusion;
- (8) length of time during which and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) the variety of goods on which a mark is or is not used;
- (10) the market interface between applicant and the owner of a prior mark;
- (11) the extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) the extent of potential confusion, i.e. whether de minimis or substantial; and
- (13) any other established fact probative of the effect of use.

DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. The *Du Pont* court recognized that when determining likelihood of confusion, "each case must be decided on its own facts . . ." and "each [of these thirteen elements] may from case to case play a dominant role." *Id.*, 476 F.2d at 1361.

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It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting ... matter that is ... suggestive of the named goods or services. ...

Exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

Trademark Manual of Examining Procedure (TMEP) §1207.01(b)(iii) (April, 2005) (citations omitted).

The presence of a descriptive term in one mark that is not found in the other mark, may be a significant factor in evaluating whether there is a likelihood of confusion. *A&H Sportswear Inc. v. Victoria's Secret Stores, Inc.*, 166 F.3d 191 (3rd Cir. 1999) (“THE MIRACLE BRA” for bras not likely to be confused with “MIRACLESUIT” for swimming suits, both being items of women’s clothing). In that case, the court considered and rejected one party’s contention “that inasmuch as the District Court found the marks were nearly identical by use of “miracle,” it erred in finding that the addition of a descriptive term (“bra” for one and “suit” for the other) to the word lessened any confusion.” *Id.* at 195).

III. THERE IS NO LIKELIHOOD OF CONFUSION.

There is no likelihood of confusion because the marks create different commercial impressions, and the common element “MAGNUM” is quite diluted. Moreover, the goods are different, and are not subject to impulse purchasing.

A. THE MARKS ARE DIFFERENT.

The mark of the present application is stylized in a distinctive font, with “Power” above and to the left of “Magnum”. The cited registration has a typed drawing.

B. THE TERM “MAGNUM” IS SUGGESTIVE AND DILUTE.

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The word “magnum” may be defined as an adjective meaning “high-powered due to a larger case and larger powder charge than other cartridges of approximately the same caliber-used of cartridges and of weapons designed to use the cartridges.” See the photocopy of the definitions of magnum, and magnum opus, from *Webster’s Third New International Dictionary* (1984), that were filed on October 7, 2005. The term “magnum opus” may be defined as a noun meaning “the greatest achievement of an artist.” Thus, the word “magnum” used as an adjective is suggestive of a great achievement.

In view of this meaning, it is hardly surprising that “magnum” has been incorporated into a relatively large number of trademarks and services marks. The TESS database indicated that 729 records have a mark comprising “magnum” in a search conducted on October 6, 2005, as shown by the printout, that was filed on October 7, 2005. When this search was further limited to cases in Class 7, the TESS database indicated 99 records have a mark comprising “magnum” as shown by the printout, that was filed on October 7, 2005 .

Some examples of marks comprising “magnum” for goods in Class 7 are shown by the printouts from the TESS database submitted on October 7, 2005. These include following:

the mark MAGNUM for “air-applied friction disc brake units and parts therefor used for industrial machinery” of Registration No. 2,892,316;

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the mark MAGNUM for “valves for industrial fluid compressors” of Registration No. 2,858,248;

the mark MAGNUM for “portable slurry pumps for construction and restoration” of Registration No. 2,586,581;

the mark MAGNUM for “drilling jar amplifier tools” of Registration No. 2,185,428;

the mark MAGNUM for “grinding tools for grinding machines” of Registration No. 2,115,877;

the mark MAGNUM for “power operated airless paint sprayers” and other goods of Registration No. 2,745,601; and

the mark MAGNUM for “high performance segmented diamond wheels for sawing, grooving and grinding concrete-asphalt pavement and gasoline, diesel and hydraulic powered, liquid cooled saws for receiving said diamond wheels” of Registration No. 1,418,933.

The use of the term “magnum” in a number of different trademarks is also reflected by the results of a search on the internet conducted on October 6, 2005. One copy of each of the web pages mentioned below was submitted on October 7, 2005. The following products are listed:

“Quickpoint Power Caulker Magnum Quart Gun”;

the “thunderbolt Magnum”;

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the term “Magnum” for the Metabo program of stationary and semi-stationary woodworking machines;

“Stanley Screwdrivers Magnum Pozidriv Standard”;

“18 HP Magnum Vertical”;

“MS440 MAGNUM”;

“MS460 MAGNUM”;

“MS660 MAGNUM”;

“MS088 MAGNUM”;

“12 Drawer Magnum Cart-Black”;

“Metabo Magnum”;

“MAGNUM cords”;

“Magnum 3G Clear”;

“Magnum 3G Welding”;

“Magnum 3G Yellow”;

“BOSCH Magnum Impact Drill”;

“Magnum 250L gun”; and

“Magnum Connection Kit”.

C. THE STATE OF THE REGISTER REFLECTS THE ABILITY OF CUSTOMERS TO DISTINGUISH “MAGNUM” MARKS.

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Customers would readily distinguish tools sold under the trademark “POWER MAGNUM (Stylized)” of the present application, from the MAGNUM drills and screwdrivers of the cited registration, just as they currently distinguish these MAGNUM drills and screwdrivers from a number of other trademarks that comprise “magnum”.

For example, a worker in a machine shop may use a MAGNUM grinding tool of Registration No. 2,115,887, in combination with a MAGNUM electric drill of cited Registration No. 1,175,844.

As another example, a construction worker sawing concrete with a MAGNUM diamond wheel of Registration No. 1,418,933, may use this in combination with a MAGNUM electric drill of cited Registration No. 1,175,844.

In each example, even though the tools are used in combination, there would be no confusion because consumers differentiate the products. The term “magnum” has a relatively dilute trademark strength.

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The trademark POWER MAGNUM (Stylized) of the present application is even more distinguishable, because it incorporates a distinctive font as well as the initial term "POWER."

D. THE GOODS ARE DIFFERENT.

The goods of the present application are "air-operated hand-held tools, namely, air-operated impact wrenches, and air-operated ratchet wrenches." These are different from the "electrically powered tools-namely, drills and screwdrivers" of the cited registration. Drills and screwdrivers are different from wrenches. Drills may drill holes for screws. Screwdrivers may drive a screw into a hole. Wrenches are used to grip nuts and bolts.

Moreover, there are significant differences between "electrically powered tools" on the one hand, and "air-operated" hand tools on the other hand. A source of electricity (such as a power outlet or a battery) is needed at the work site, in order to use electrically powered tools. In contrast, an air compressor is needed at the work site, in order to use air-operated hand tools.

E. OTHER FACTORS.

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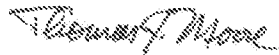
There is no evidence of the fame of either mark, or the length of time of simultaneous use of the marks, or any market interface between applicant and registrant. There has been no confusion. See the Declaration filed on December 5, 2006. In regard to the extent of the right to exclude others, searches in both the Lexis and Westlaw databases, noted no cases enforcing a trademark comprising "magnum" for any goods or services.

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CONCLUSION

Applicant respectfully submits that the application should be approved for publication because there is no likelihood of confusion.

Respectfully submitted,



Thomas J. Moore
Applicant's Attorney

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: 703-683-0500
Fax: 703-683-1080
E-mail: mail@baconthomas.com
Date: April 30, 2007

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